UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
CHANG, JUNGWON

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _10 September 2008_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-16_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-16_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _6/16/08_.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is in response to amendment filed on 09/10/2008. Claims 1-16 are

presented for examination.

2.   The specification objection is withdrawn in view of the amendment.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-5 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Couts et al. (US 2003/0120805), hereinafter Couts, in view of Srinivas et al, (US

7,249,161), hereinafter Srinivas.

5.   As to claim 1, Couts discloses a first communication device comprising:

        means for receiving an instant messaging (IM) message (214, fig. 2) from a

sender directed to a first IM address (each IM user is inherently assigned a unique

instant messaging address; page 3, 0027, "the originating device allows forwarding of

messages"); and

        means for prompting the sender to convey the IM message to a second IM

address on a second communication device (another device or next device) (214, 228,

fig. 2; page 1, 0010, "would prompt the system to forward the message to another

device"; page 2, 0013, "target device is not available to receive an incoming

message...forwards the message to another or next device...interactive communication

is conducted in real time between an originating user of the originating device and a

next user of the next device"; page 3, 0027, "if the target device is not available...the

originating device allows forwarding of messages);

means for conveying the IM message to a second IM address on a second

communication device (each IM user is inherently assigned a unique instant messaging

address; 228, fig. 2, "message forwarded to the available next user or device").

6.   Couts does not specifically disclose means for indicating to the second

communication device that the message originated from the sender. However, Srinivas

discloses means for indicating to the second communication device that the message

originated from the sender (col. 5, lines 15-30). It would have been obvious to one of

ordinary skill in the art at the time of the invention was made to combine the teachings

of Couts and Srinivas because Srinivas' teaching would allow the recipient to be aware

that where the message is coming from, as taught by Srinivas (col. 5, lines 15-30).

7.   As to claim 2, it is rejected for the same reasons set forth in claim 1 above. In

addition, Couts discloses a first communication device comprising:

receive logic configured to receive, from a sender, an instant messaging (IM)

message (214, fig. 2) directed to a first IM address (each IM user is inherently assigned

a unique instant messaging address; page 3, 0027, "the originating device allows

forwarding of messages"); and

      prompt logic configured to the sender to convey the IM message to a second IM

address on a second communication device (another device or next device) (214, 228,

fig. 2; page 1, 0010, "would prompt the system to forward the message to another

device"; page 2, 0013, "target device is not available to receive an incoming

message...forwards the message to another or next device...interactive communication

is conducted in real time between an originating user of the originating device and a

next user of the next device"; page 3, 0027, "if the target device is not available...the

originating device allows forwarding of messages);

      convey logic configured to convey the IM message to a second IM address on a

second communication device (each IM user is inherently assigned a unique instant

messaging address; 228, fig. 2, "message forwarded to the available next user or

device").

8.   As to claim 3, Couts discloses wherein the convey logic is further configured to

automatically convey the IM message to the second communication device (page 1,

0001, "automatically forwarding").

9.   As to claim 4, it is rejected for the same reasons set forth in claim 1 above. In

addition, Couts discloses a communication method comprising:

receiving an instant messaging (IM) message at a first communication device,

the IM message being intended for a recipient at a first IM address (204, fig. 2); and

prompting the sender to convey the IM message to a second IM address on a

second communication device (another device or next device) (214, 228, fig. 2; page 1,

0010, "would prompt the system to forward the message to another device"; page 2,

0013, "target device is not available to receive an incoming message...forwards the

message to another or next device...interactive communication is conducted in real time

between an originating user of the originating device and a next user of the next

device"; page 3, 0027, "if the target device is not available...the originating device

allows forwarding of messages);

conveying the IM message to the second IM address on the second

communication device (228, fig. 2, "message forwarded to the available next user or

device").

10.   As to claim 5, Couts discloses further comprising the step of: determining

presence of the intended recipient at the second communication device prior to

conveying the IM message to the second communication device (226, fig. 2, "next

device available").

11.   As to claim 11, it is rejected for the same reasons set forth in claim 1 above. In

addition, Couts discloses a computer-readable storage medium comprising: computer-

readable code adapted to instruct a programmable device (page 2, 0015, "memory for

storage of applications and data; page 3, 0020, "client software stored by the client

devices").

12.   As to claim 12, it is rejected for the same reasons set forth in claim 5 above.

13.   Claims 6-10 and 13-16 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Appelman et al. (US 6,539,421), hereinafter Appelman, in view of

Srinivas et al, (US 7,249,161), hereinafter Srinivas.

14.   As to claim 6, Appelman discloses a communication method comprising the

steps of:

        receiving an instant messaging (IM) message intended for a recipient, the

recipient having IM addresses, the IM message including a designated IM address of

the IM addresses for delivering the IM message (col. 3, lines 4-11, "receiving addresses

of instant message recipients");

        determining a presence of the recipient at each of the IM addresses (506, fig. 9;

col. 5, line 43 – col. 6, line 7, "entries 502 for persons who are currently online, which is

determined by checking the online status fields 506"); and

        prompting the sender to convey the IM message to a second IM address on a

second communications device (another device) (col. 2, lines 12-19, "instant messages

can be sent to another user only when the user is presently signed on to the computer

service"; col. 3, lines 40-59, "the user interface allows a user to send instant messages

to exchange comments with a plurality of other users"; col. 5, line 66 – col. 6, line 7, "a

subset of the group of potential recipients");

conveying the received IM message to the IM addresses at which the recipient is

present (col. 6, line 16 – col. 7, line 7; col. 8, lines 10-30; col. 14, lines 45-49, "potential

instant message recipient is currently online").

15.   Appelman does not specifically disclose means for indicating to the second

communication device that the message originated from the sender. However, Srinivas

discloses means for indicating to the second communication device that the message

originated from the sender (col. 5, lines 15-30). It would have been obvious to one of

ordinary skill in the art at the time of the invention was made to combine the teachings

of Appelman and Srinivas because Srinivas' teaching would allow the recipient to aware

where the message is coming from, as taught by Srinivas (col. 5, lines 15-30).

16.   As to claim 7, is rejected for the same reasons set forth in claim 6 above. In

addition, Appelman discloses a communication method comprising:

receiving an instant messaging (IM) message intended for a recipient, the

recipient having IM addresses, the IM message including a designated IM address of

the IM addresses for delivering the IM message (col. 3, lines 4-11, "receiving addresses

of instant message recipients");

determining a last active time for each of the IM addresses (508, fig. 9, "time

stamp"; col. 6, line 16 – col. 6, line 7, "the most recent time in its time stamp field 506");

prompting the sender to convey the IM message to a second IM address on a

second communications device (another device) (col. 2, lines 12-19, "instant messages

can be sent to another user only when the user is presently signed on to the computer

service"; col. 3, lines 40-59, "the user interface allows a user to send instant messages

to exchange comments with a plurality of other users"; col. 5, line 66 – col. 6, line 7, "a

subset of the group of potential recipients");

conveying the received IM message to the IM address having a most recent last

active time (508, fig. 9, "time stamp"; col. 8, lines 10-30, "Barry was corresponded with

more recently than Bartholomew"; col. 6, line 16 – col. 6, line 7, "the most recent time in

its time stamp field 506")

17.   As to claim 8, Appelman discloses further comprising: determining a presence of

the recipient at each of the IM addresses prior to determining the last active time (506,

fig. 9; col. 5, line 43 – col. 6, line 7, "entries 502 for persons who are currently online,

which is determined by checking the online status fields 506"); and wherein determining

the last active time comprises determining the last active time for each of the IM

addresses at which the recipient is present (508, fig. 9, "time stamp"; col. 6, line 16 –

col. 6, line 7, "the most recent time in its time stamp field 506").

18.   As to claim 9, Appelman discloses, wherein conveying the received IM message

comprises: conveying the IM message to a most recent IM address at which the

recipient is present, the most recent IM address being the IM address having the most

recent last active time (508, fig. 9, "time stamp"; col. 8, lines 10-30, "Barry was

corresponded with more recently than Bartholomew"; col. 6, line 16 – col. 6, line 7, "the

most recent time in its time stamp field 506").

19.   As to claim 10, Appelman discloses further comprising: determining a presence

of the recipient at each of the IM addresses (506, fig. 9; col. 5, line 43 – col. 6, line 7,

"entries 502 for persons who are currently online, which is determined by checking the

online status fields 506"); wherein conveying the received IM message comprises the

step of conveying the received IM message to the IM address at which the recipient is

present (508, fig. 9, "time stamp"; col. 8, lines 10-30, "Barry was corresponded with

more recently than Bartholomew"; col. 6, line 16 – col. 6, line 7, "the most recent time in

its time stamp field 506").

20.   As to claim 13, it is rejected for the same reasons set forth in claim 6 above. In

addition, Appelman discloses a computer-readable storage medium comprising:

computer-readable code adapted to instruct a programmable device (col. 13, lines 30-

56).

21.   As to claim 14, it is rejected for the same reasons set forth in claim 7 above. In

addition, Appelman discloses a computer-readable storage medium comprising:

computer-readable code adapted to instruct a programmable device (col. 13, lines 30-

56).

22.   As to claim 15, it is rejected for the same reasons set forth in claim 8 above. In

addition, Appelman discloses a computer-readable storage medium comprising:

computer-readable code adapted to instruct a programmable device (col. 13, lines 30-

56).

23.   As to claim 16, it is rejected for the same reasons set forth in claim 9 above. In

addition, Appelman discloses a computer-readable storage medium comprising:

computer-readable code adapted to instruct a programmable device (col. 13, lines 30-

56).

Response to Arguments

24.   Applicant's arguments filed 09/10/08 have been fully considered but they are not

persuasive:

(1)   Applicant asserts that Couts, Srinivas, or Appelman taken alone or in

combination, does not disclose, teach, or suggest a "prompting the sender to convey

the IM message to a second IM address on a second communication device."

        The examiner respectfully disagrees. Srinivas explicitly discloses prompting the

sender to convey the IM message to a second IM address on a second communications

device (fig. 3; col. 4, lines 17-33, "*a sender 12 enters a message directed to a*

recipient 14...the sender and/or recipient may alternatively use a computer

terminal...*the sender will be designated as Mitri using the IM address*

mitri@wv.com **and the recipient will be designated as Srini using the IM address**

srini@icq.com"). In addition, Couts explicitly discloses users are communicating using

the Instant Messaging System (page 1, 0002-0003) and on page 5, 0041 of Couts

states that **User A tries to send a communication message (IM message) to User**

D. The User A is the sender who tries to send the communication message (IM

message) to the User D who will receive the IM message from the sender.

25.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

26.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jungwon Chang whose telephone number is 571-272-

3960. The examiner can normally be reached on 6:30-2:00 (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Nathan J. Flynn can be reached on 571-272-1915. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JUNGWON CHANG/
Primary Examiner, Art Unit 2454
December 8, 2008

Application Number	**Application/Control No.**	**Applicant(s)/Patent under Reexamination**
	10/685,970	MALIK, DALE W.
	Examiner	**Art Unit**	
	JUNGWON CHANG	2454	